

### REMARKS

Claims 1 and 10 have been amended to address the Examiner's objections based on informalities. Similar amendments were made to claim 17. Claims 1, 10 and 17 have also been amended to address the Examiner's 35 U.S.C. §112 rejections, by correcting the formula for the hydrocarbyl phosphite. Support for this amendment may be found on page 16, line 30 of the specification. Accordingly, these objections and rejections should be withdrawn.

The Examiner rejected claims 1-3, 6, 8, 10, 11 and 17-20 under 35 U.S.C. §103(a) as unpatentable over Ichihashi (US 5,792,731) in view of Nibert (US 5,750,476). The Applicants respectfully disagree.

Ichihashi teaches a lubricant composition for transmissions comprising a sulfur-based extreme pressure agent, a phosphorus-based extreme pressure agent and an alkaline earth metal-based detergent. Ichihashi does not disclose, suggest or teach the friction modifiers required by the Applicants. Therefore, the claimed invention is novel and non-obvious over Ichihashi.

Nibert teaches a lubricant for transmission fluids comprising a low potency friction modifier and an oil-soluble phosphorus containing compound. Nibert teaches that this transmission fluid may also contain overbased metallic salts and polyol esters. Nibert does not disclose, suggest or teach the organic sulfonic acid or organic acylating agent salt with the hydrocarbyl phosphite and friction modifiers required by the Applicants. Therefore, the claimed invention is novel and non-obvious over Nibert.

The Examiner is of the position that it would have been obvious to one skilled in the art to combine these references and thereby result in the composition claimed by the Applicants. The Applicants respectfully disagree.

Combining the teaching of Nibert into Ichihashi does not teach the addition of a polyol ester to the composition in Ichihashi but rather the addition of the low potency friction modifier required by Nibert and an oil-soluble phosphorus containing compound. The combination of references may also teach the addition of the required low potency friction modifier, an oil-soluble phosphorus containing compound, and either overbased metallic salts or polyol esters to the composition in Ichihashi. No combination of Ichihashi and Nibert teaches or suggests the addition of polyol esters alone to the composition of Ichihashi. Therefore, no combination of Ichihashi and Nibert disclose, suggest or teach the Applicants' claimed invention.

Finally, Applicants have added a new claim. Claim 21 claims a lubricating composition comprising a major amount of an oil of lubricating viscosity and (A) a basic salt of an organic sulfonic acid or organic acylating agent; (B) a hydrocarbyl phosphite represented by the formula  $(R_5O)_3P$  and (C) a friction modifier comprising a borated glycerol ester; wherein each  $R_5$  is independently hydrogen or a hydrocarbyl group and at least one  $R_5$  is hydrocarbyl, provided that the lubricant is free of metal deactivators, wherein the basic metal salt (A) is an overbased material and the ratio of equivalents of overbased material based on the total base number to equivalents of hydrocarbyl phosphite based on phosphorus atoms is at least one. Support for this new claim, and specifically the borated friction modifiers required by the claim, may be found on page 19, lines 13-20 of the specification.

Neither Ichihashi or Nibert, alone or in combination, disclose, suggest or teach the use of borated glycol ester friction modifiers. Therefore, claim 21 is novel and non obvious over the references.

In view of the foregoing amendment and remarks, Applicants have shown their invention to be both novel and unobvious over the prior art. Accordingly, Applicants respectfully request allowance of all the claims in the application.

If for any reason the Examiner believes that a telephone conference would expedite the prosecution of this application, I can be reached at the telephone number listed below.

Any required fees or any deficiency or overpayment in fees should be charged or credited to The Lubrizol Corporation Deposit Account No. 12-2275.

Respectfully submitted,

THE LUBRIZOL CORPORATION

/Christopher D. Hilker #58510/

Christopher D. Hilker  
Agent for Applicant  
Registration No. 58,510

29400 Lakeland Blvd.  
Wickliffe, Ohio 44092-2298  
Telephone: 440-347-5072  
Facsimile: 440-347-1110